

### **REMARKS**

This Amendment and Reply is filed in response to the Office action mailed April 8, 2002. It is being filed within the shortened three month period set for response and no Petition for Extension of Time or fee is therefore required.

Claims 2-9, 11, 17 and new claims 18-19 are pending in this application. It is noted that claim 10 had been previously cancelled by Applicant in the Amendment and Reply dated January 22, 2002. Claim 17 has been amended, and claims 18 and 19 have been added. Support for the amendment to claim 17 may be found in the specification, such as the disclosure on page 12, lines 6-11. New claim 18 recites subject matter found at least on page 12, lines 6-11 of the specification. Claim 19 has been added to specifically recite subject matter that is recited in independent claim 17.

It is urged that there is a clear basis in the application, as filed, for the claim amendments and the newly added claims. The claim amendments and claim addition are not made for any reason related to patentability but, rather, to more clearly and specifically recite the invention.

### **Rejections under §103(a)**

Claims 3-8 and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Poot, et al, U.S. Patent No. 6,291,203 (hereinafter referred to as "Poot"). Since all previously pending claims (2-9, 11 and 17) have been rejected, Applicant assumes that this rejection over Poot also extends to claims 2, 9, and 11.

Applicants do not acquiesce in this rejection. For purposes of expediting prosecution, however, the claims have been amended to clarify that the screening of contrast enhancing agents is to determine agents useful for distinguishing malignant, pathological or dysfunctional cells or tissues.

By comparison, Poot describes testing agents for its ability to stain mitochondria. In Poot Example 18, a test is described that determines the length of time in which a dye that stains mitochondria lasts, i.e. photobleaching rate, so that the image can be photographed. Furthermore, in Poot Example 19, a test is described for determining the agent's specificity for staining mitochondria. Nowhere in Poot is it described or suggested that an agent is screened for its usefulness to specifically distinguish malignant, pathological or dysfunctional cells or tissues. It

is urged, therefore, that this rejection may be properly withdrawn with regard to independent claim 17 and the claims (2-9, 11, 18 and 19), which depend from claim 17.

Applicant further submits that the newly added claim 18 also is not taught or implied by Poot. Claim 18 recites that at least one sample population is malignant or pathological cells and the usefulness of the agent in distinguishing the malignant or pathological cells is determined. Poot fails to describe a method that specifically employs malignant or pathological cells and determines the usefulness of the agent to distinguish such cells. Since the entire disclosure in Poot is drawn to the ability of agents to stain mitochondria, the reference disclosure does not provide the requisite motivation to particularly use malignant or pathological cells to screen for agents that distinguish such cells.

In addition, new claim 19 recites that the biological material is an organ culture system. Applicant believes that Poot does not suggest that the testing that the sample may be an organ culture system. Rather, Poot describes samples of "fresh or cultured cells, cell lines, cells in biological fluids, cells in tissue or biopsy and yeast cells." Poot, col. 8, lines 38-41.

For at least the reasons discussed above, Applicant urges that the previously pending and new claims are not made obvious by Poot.

### **Conclusion**

Accordingly, in view of the above remarks, it is submitted that this application is now ready for allowance. Early notice to this effect is solicited.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "**Version with markings to show changes made.**"

If the Examiner has any questions or comments, Applicant respectfully requests that the Examiner contact the undersigned by telephone at (206) 382-1191.

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Respectfully submitted,



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Date: June 19, 2002

**SPECKMAN LAW GROUP**



20601

In re Daryl W. Hochman

Application No.: 09/326,244

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**In the Claims:**

Claim 17 has been amended as follows:

17. (Four times amended) A method for identifying optical contrast enhancing agents useful for enhancing the sensitivity of optical detection of a biological material comprising:

maintaining at least one sample population of the biological material in one of the following systems: a cell culture system; a tissue culture system; an organ culture system; and an intact organism;

exposing the at least one sample population to a candidate optical contrast enhancing agent;

acquiring test data relating to one or more optical properties of the sample population subsequent to exposure to the candidate optical contrast enhancing agent; [and]

comparing the test data acquired to comparison data relating to the one or more optical properties of the sample population, whereby changes in the one or more optical properties reflected in the test data compared to the comparison data represent the optical contrast enhancing activity of said agent in said sample population; and [identify an agent that is useful for enhancing the sensitivity of optical detection in said population]

based on the comparison data, determining if the optical contrast enhancing agent is useful for distinguishing malignant, pathological or dysfunctional cells or tissue.